



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/957,471

09/21/2001

Kimihiko Nishioka

P 283651 OL97501N-US

4064

909

7590

07/27/2007

PILLSBURY WINTHROP SHAW PITTMAN, LLP

P.O. BOX 10500

MCLEAN, VA 22102

EXAMINER

LESTER, EVELYN A

ART UNIT

PAPER NUMBER

2873

MAIL DATE

DELIVERY MODE

07/27/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/957,471

Applicant(s)

NISHIOKA ET AL.

Examiner

Evelyn A. Lester

Art Unit

2873

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 May 2007.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18, 20-22, 24-37 and 40 is/are pending in the application.
4a) Of the above claim(s) 1-4, 7-18, 20 and 27-37 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 5, 6, 21, 22, 24-26 and 40 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 21 September 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5-2-07 has been entered.

Priority

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Specification

3. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Status of the Claims

4. Claims 1-4, 7-18, 20 and 27-37 are withdrawn as being directed to a non-elected invention. Claims 19, 23, 38 and 39 were cancelled, previously, by the Applicants. Claims 5, 6, 21, 22, 24-26 and 40 are pending and have been examined hereby.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 5, 6, 21, 22, 24-26 and 40 are rejected under 35 U.S.C. 102(b) as being anticipated by Hamada et al (U.S. Patent 4,989,958).

Hamada et al discloses the claimed invention of a variable optical characteristic unit and an imaging system, incorporating the variable-focus optical unit, as noted in Figure 1 and its accompanying text.

As noted Hamada et al's invention has a variable optical characteristic element (7) with a fluid portion (i.e. water-aceton mixture solution), and an electrode (8 and/or 9) adjacent to the fluid portion. Their invention further has a power source (11) and a driving circuit (3,4,5), which drive the variable optical characteristic element. Hamada et al's power source or driving circuit includes a "booster member" (3-CCD) that generates

Art Unit: 2873

or applies a voltage necessary in the driving circuit (please note in Hamada et al at, for example, col. 4, line 50 to col. 5, line 2). Hamada et al's invention variable optical characteristic element is capable of achieving optical deflection through its operation.

With respect to claim 6, Hamada et al's invention utilizes electrostatic force for driving the variable optical characteristic element.

With respect to claim 21, Hamada et al meets the additional limitation of having a deformable surface (please note for example Figs. 3A and 3B, and their accompanying text, as well as for example the Abstract).

Hamada et al's invention is a varifocal lens, therefore claim 22 is well met.

With respect to claim 24, Hamada et al's invention has an image pick-up device, such as a CCD (3).

With respect to claims 25 and 26, as noted above, Hamada et al's invention has a variable-focus optical element (7), a computing unit (5) and an image pick-up device (3). Their invention further has a power source and a driving circuit, or a control system (11), which drive the variable-focus optical element. Hamada et al's power source or driving circuit, or control system, includes a "booster member" (4) that generates a voltage necessary in the driving circuit (please note in Hamada et al at, for example, col.

4, line 50 to col. 5, line 2). Hamada et al's computing unit examines a high-frequency component of each image picked up while being defocused, and the position where the high-frequency component reaches a maximum is determined to be an in-focus position (please note col. 4, line 22 to col. 5, line 25).

With respect to claim 40, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Response to Arguments

6. Applicant's arguments, filed on 5-2-07, with respect to claims 5, 6, 21, 22 and 24-26, and claim 40, have been considered but are moot in view of the new ground(s) of rejection.

Hamada et al has been reconsidered and interpreted in a different light, thereby presenting "new grounds of rejection." Hamada et al's CCD (charged coupled device) is interpreted as the "booster member" because of the charge packets created through the operation of the CCD, which are then applied to the "drive circuit", which in turn is connected to the "power source," as explained above in the rejection. Therefore, in response to Applicant's argument that Hamada et al does not explicitly or implicitly disclose each of the claimed elements, the law of anticipation requires that a distinction be made between the invention described or taught and the invention claimed. It does

Art Unit: 2873

not require that the reference "teach" what the subject patent teaches. Assuming that a reference is properly "prior art," it is only necessary that the claims under consideration "read on" something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or "fully met" by it. Hamada et al fully meets the claimed limitations and elements as explained in the rejection presented above.

With respect to the "variable optical characteristic" limitation, Hamada et al discloses a variable-focus element which is a "variable optical characteristic" element, i.e. change in focus.


Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Evelyn A. Lester whose telephone number is (571) 272-2332. The examiner can normally be reached on M-F, subject to an increased flex schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ricky L. Mack can be reached on (571) 272-2333. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2873

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Evelyn A. Lester
Primary Examiner
Art Unit 2873